

Office Action Summary

Application No.

08/953,477

Applicant(s)

KARA ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-74 and 90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-74 and 90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 11/20/00, and has been entered and made of record. Currently, **claims 57 through 74, and 90** are pending.

Response to Arguments

2. Applicant's arguments filed 11/20/00 have been fully considered but they are not persuasive.

3. In response to applicant's arguments regarding the rejection of *claim 57*, stating on pages 5 and 6, that Kunigami fails to teach of an intermediate location comprising a reproducing circuit adapted to reproduce either information or an indicia of payment in human readable form. The examiner notes the limitation in the claim, stating "a reproducing circuit adapted to reproduce said information in human readable form, wherein said reproducing circuit also produces an indicia of payment authorizing delivery of said human readable information to said selected location." As the claim is written, the "indicia of payment" is not required to be in "human readable form", as the reproducing circuit produces an indicia of payment of the human readable information. Further, the term "human readable information" is not clearly defined, and can be interpreted as an electronic mail being displayed on a monitor, which is information readable by a human, as taught by Kunigami. Kunigami teaches of a reproducing circuit which produces an indicia of payment authorizing delivery of the human readable information to the selected

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location (see Fig. 4A, "Fee Payer Identifier" being an "O" or a "D", column 3, line 57 through column 4, line 25).

Continuing, in response to applicant's argument on page 6, stating that Kunigami fails to teach of an indicia of payment which authorizes delivery, as it cannot be said that the fee payer identifier authorizes delivery of the electronic mail. Kunigami teaches that the mail receiver views the "Fee Payer Identifier", as seen in Fig. 4A, wherein when the identifier is an "O", representing that the mail is paid for by the sender, the mail is authorized for delivery to the recipient, and when the identifier is a "D", representing that the recipient is to pay the transmission charge, meaning that the sender did not pay, the mail is *not* authorized. Because of this, the Kunigami can be interpreted as producing "an indicia of payment authorizing delivery of said human readable information to said selected location", as required by the claim.

Further, in response to applicant's argument on page 7, stating that the motivation provided for combining Albal and Kunigami is improper, as the motivation must establish the desirability for making the modification. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation for combining Kunigami's teachings in Albal's system is that Albal's system would become *more efficient*, as the intermediate station informs the receiver if the payment is performed by the sender, therein

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allowing the recipient to choose any desired mail, thus preventing unwanted, or unpaid mail from being sent or stored at the receiver.

Further, in response to applicant's argument on page 7, stating that the motivation provided for combining Albal and Berkowitz is improper, as the motivation must establish the desirability for making the modification. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation for combining Berkowitz's teachings in Albal's system is that Albal's system would become *more versatile*, as more user's would be capable of using the system.

4. Therefore, the rejection of **claim 57**, as cited in the Office action dated 8/21/00, under 35 U.S.C. 103(a) as being unpatentable over Albal (U.S. Patent Number 5,826,034) in view of Kunigami (U.S. Patent Number 5,508,817), and further in view of Berkowitz *et al.* (U.S. Patent Number 5,903,877) is maintained, and repeated in this Office action.

5. In response to applicant's argument regarding the rejection of **claim 72**, stating on page 7, that Albal fails to meet the requirement that the time of transmission is transmitted with the document from the transmitting location. Firstly, the claim does not specifically teach of the time of transmission being transmitted with *the document*. The examiner notes that "a document" is not claimed in claim 57, 65 or 72, as claim 57 teaches of transmitting "information". Continuing,

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Albal teaches in column 9, lines 1 through 3 that delivery parameters can include the time for a delayed delivery. Further, Albal teaches that the delivery parameters are transmitted in column 4, lines 25 through 55, and column 9, lines 38 through 49. Because of this, it can be seen that Albal teaches of transmitting a time of transmission.

Continuing, in response to applicant's argument, stating on page 8, that Albal fails to teach of providing a time by a secure time piece disposed at the transmitting location. Albal teaches that the delivery parameters can include a time for delayed delivery (column 9, lines 1 through 3). In generating a time, a computer inherently uses a time piece. As applicant states, workstations are typically provided with a real time clock. This time piece, which would inherently be in the computer which sets a time for delayed delivery, is secure within the computer, therein being a secure time piece.

6. Therefore, the rejection of **claim 72**, as cited in the Office action dated 8/21/00, under 35 U.S.C. 103(a) as being unpatentable over Albal (U.S. Patent Number 5,826,034) in view of Kunigami (U.S. Patent Number 5,508,817), and further in view of Berkowitz *et al.* (U.S. Patent Number 5,903,877) is maintained, and repeated in this Office action.

7. In response to applicant's arguments regarding the rejection of **claim 68**, stating on page 8, that Maxwell does not teach of transmission of ancillary information including a value data packet for funding the delivery of the information which is transmitted from the transmission location. The primary reference of Albal teaches of including ancillary information, which includes a means for funding delivery of the transmitted information (column 8, line 66 through column 9, line 3), with the transmitted information (column 8, lines 28 through 52, and column

9, lines 38 through 47). However, Albal lacks teaching if the funding means includes at least a value data packet. Maxwell is being relied upon to teach of a value data packet which is included in a funding means. Maxwell teaches of a funding means which includes at least a value data packet (column 9, lines 19 through 47). Because of this, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Maxwell's teachings in Albal's system, thereby having the funding means be included in the transmitted information, as taught by Albal, wherein a value data packet can be included in the funding means, as taught by Maxwell.

8. Therefore, the rejection of **claim 68**, as cited in the Office action dated 8/21/00, under 35 U.S.C. 103(a) as being unpatentable over Albal (U.S. Patent Number 5,826,034) in view of Kunigami (U.S. Patent Number 5,508,817), in view of Berkowitz *et al.* (U.S. Patent Number 5,903,877), and further in view of Maxwell (U.S. Patent Number 5,805,810) is maintained, and repeated in this Office action.

9. In response to applicant's arguments regarding the rejection of **claim 69**, stating on page 9, that Kunigami does not teach of value deducted from a credit stored at the transmission of ancillary information including a value data packet for funding the delivery of the information which is transmitted from the transmission location. The combination of Albal, Kunigami, Berkowitz, and Maxwell teach of ancillary information including a value data packet for funding the delivery of the information which is transmitted from the transmission location, seen in the rejections of claims 57, 65, 66, and 68. Further, Kunigami teaches that a value is deducted from a credit stored at the transmitting location in column 7, lines 53 through 60, and Fig. 11C, wherein

Fig. 11C, which shows a generated report which is sent to the sender 1, showing that the transmission fee is subtracted (-10 Yen). Because the generated bill is issued to the sender, it would be obvious to a person of ordinary skill in the art that the value of the bill is deducted from a credit stored at the transmitting location, such as a checking account, credit card, credit register, postage meter, etc., all of which are well known in the art. Therefore, it would be obvious to a person of ordinary skill in the art at the time the invention was made to include Kunigami's further teachings in the combination system of Albal, Kunigami, Berkowitz, and Maxwell, therein teaching of a value being deducted from a credit stored at the transmission of ancillary information including a value data packet for funding the delivery of the information which is transmitted from the transmission location.

10. Therefore, the rejection of **claim 69**, as cited in the Office action dated 8/21/00, under 35 U.S.C. 103(a) as being unpatentable over Albal (U.S. Patent Number 5,826,034) in view of Kunigami (U.S. Patent Number 5,508,817), in view of Berkowitz *et al.* (U.S. Patent Number 5,903,877), and further in view of Maxwell (U.S. Patent Number 5,805,810) is maintained, and repeated in this Office action.

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. **Claims 57 through 66, 70 through 74, and 90** are rejected under 35 U.S.C. 103(a) as being unpatentable over Albal (U.S. Patent Number 5,826,034, cited in the Office action dated 8/21/00) in view of Kunigami (U.S. Patent Number 5,508,817, cited in the Office action dated

8/21/00), and further in view of Berkowitz *et al.* (U.S. Patent Number 5,903,877, cited in the Office action dated 8/21/00).

Regarding *claim 57*, Albal discloses a system for delivering information to a selected location (workstations 36 and 46, and fax 44, shown in Fig. 1, and workstation 36, shown in Figs. 5 through 9) from a transmitting location (workstation 30, shown in Fig. 1, and Figs. 5 through 9), wherein the system comprises a transmission station operable at the transmitting location and adapted to transmit the information (column 3, lines 24 through 33) to an intermediate location (payload delivery system 62, being located in various locations, column 6, lines 33 through 48), and an intermediate station operable at the intermediate location (column 6, lines 49 through 60) and adapted to receive the information transmitted (column 6, line 49 through column 7, line 18) by the transmitting means (column 3, lines 31 through 65). Further, the intermediate station comprises a converter circuit (media/protocol converter 88) adapted to electronically receive the transmitted information and to convert the transmission to electronic form (column 7, lines 47 through 59), and a reproducing circuit adapted to reproduce the information in human readable form, wherein the reproducing circuit also produces an indicia authorizing delivery of the human readable information to the selected location (column 9, lines 38 through 64, wherein the seal is produced which authorizes delivery).

However, Albal fails to teach of the reproducing circuit producing an indicia of payment authorizing delivery of the human readable information to the selected location. Kunigami discloses a system which delivers information to a selected location (receiver 3, seen in Figs. 1 and 2) from a transmitting location (sender 1, seen in Figs. 1 and 2), wherein an intermediate station (electronic mail center 2, seen in Figs. 1 and 2) comprises a reproducing circuit which

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produces an indicia of payment authorizing delivery of the human readable information to the selected location (see Fig. 4A, "Fee Payer Identifier" being an "O" or a "D", column 3, line 57 through column 4, line 25). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kunigami's teachings in Albal's system, thereby having the reproducing circuit producing an indicia of payment (Fee Payer Identifier) authorizing delivery of the human readable information to the selected location. Albal's system would become more efficient and more automated if modified to incorporate Kunigami's teachings, as the sender or receiver would be responsible for payment, wherein the intermediate station informs the receiver if the payment is performed by the sender.

Continuing, Albal fails to teach of the converter circuit (media/protocol converter 88) being adapted to electronically receive the transmitted information and to convert the transmission to electronic form if the transmitted information is not initially in electronic form. Berkowitz discloses a system which transmits information through a plurality of devices (column 3, lines 52 through 59) to an intermediate device (transaction request server 20), wherein a converter circuit is adapted to electronically receive the transmitted information and to convert the transmission to electronic form if the transmitted information is not initially in electronic form (column 3, line 67 through column 4, line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Berkowitz's teachings in Albal and Kunigami's system. Albal's system would become more versatile with the addition of Berkowitz's converter circuit, as more users would be able to send information electronically, wherein the user's do not have electronic mail capabilities or facsimile machines.

Regarding *claim 58*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 57, and Albal further teaches of the intermediate location being selected according to proximity to the selected location (column 3, lines 31 through 49, and column 6, lines 33 through 60).

Regarding *claim 59*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 58, and Albal further teaches of the intermediate location selection is accomplished automatically by the transmitting location through reference to address information with respect to the selected location (column 3, lines 31 through 49, wherein if the sender workstation contains the first payload delivery system, seen in column 6, lines 49 through 60, then the second payload delivery system is selected through reference to the destination address).

Regarding *claim 60*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 57, and Albal further teaches of the intermediate location is selected according to proximity to the transmitting location (column 3, lines 31 through 49, and column 6, lines 33 through 60).

Regarding *claim 61*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 57, and Albal further teaches of the converter circuit comprises circuitry adapted to accept electronic documents communicated utilizing different communication protocols (column 7, lines 47 through 59).

Regarding *claim 62*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 61, and Albal further teaches of the different communication protocols include at least two protocols selected from the group consisting of a standardized electronic mail

communication protocol (column 8, lines 34 through 37), a special purpose mail communication protocol, a standardized facsimile protocol (column 7, lines 34 through 37), a standardized character based protocol, and a standardized packet based protocol.

Regarding *claim 63*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 57, and Albal further teaches of the converter circuit comprising circuitry adapted to determine delivery address information with respect to the selected location from information contained within the transmitted information (column 7, lines 47 through 59, and column 8, lines 28 through 52).

Regarding *claim 64*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 63, and Albal further teaches of the converter circuit comprising circuitry adapted to verify the accuracy of the delivery address information (column 3, lines 31 through 37).

Regarding *claim 65*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 57, and Albal further teaches of a means for including ancillary information with the transmitted information, wherein the ancillary information being suitable for use by the receiving means in delivery of the transmitted information to the selected location (column 8, lines 28 through 52, and column 9, lines 38 through 47).

Regarding *claim 66*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 65, and Albal further teaches of the ancillary information comprising means for funding delivery of the transmitted information (column 8, line 66 through column 9, line 3).

Regarding *claim 70*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 65, and Albal further teaches of the ancillary information includes a delivery address of the selected location (see Fig. 4, column 8, lines 34 through 52).

Regarding *claim 71*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 70, and Albal further teaches of the converter circuit comprises a means for verifying the accuracy of the delivery address information (column 3, lines 31 through 37).

Regarding *claim 72*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 65, and Albal further teaches of the ancillary information includes a time of transmission of the document by the transmitting means (column 9, lines 1 through 3), wherein the time being provided by a secure time piece disposed at the transmitting location (wherein a secured time piece would inherently be used by a workstation).

Regarding *claim 73*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 65, and Albal further teaches of the ancillary information includes specific delivery information regarding the delivery of the human readable information, indicating selection of at least one delivery option of a plurality of delivery options available for delivery of the transmitted information (see Fig. 4).

Regarding *claim 74*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 57, and Albal further teaches of the reproducing circuit is operable at least in part with corresponding circuitry disposed at the selected location (column 6, line 33 through column 7, line 59).

Regarding *claim 90*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 57, and Albal further teaches of the intermediate station further comprising an acknowledgment circuit adapted to produce an acknowledgment of receipt of the transmitted information (output manager 84, column 8, lines 24 through 26, and see Figs. 5 through 9, near-

end acknowledgment 120, wherein the acknowledgment 120 is produced by a circuit in the near-end server 28).

13. **Claims 67 through 69** are rejected under 35 U.S.C. 103(a) as being unpatentable over Albal (U.S. Patent number 5,826,034, cited in the Office action dated 8/21/00) in view of Kunigami (U.S. Patent Number 5,508,817, cited in the Office action dated 8/21/00), further in view of Berkowitz *et al.* (U.S. Patent Number 5,903,877, cited in the Office action dated 8/21/00), and further in view of Maxwell (U.S. Patent Number 5,805,810, cited in the Office action dated 8/21/00).

Regarding **claim 67**, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 66, and Albal further teaches of the intermediate station further comprising an acknowledgment circuit adapted to produce an acknowledgment of receipt of the transmitted information (output manager 84, column 8, lines 24 through 26, and see Figs. 5 through 9, near-end acknowledgment 120, wherein the acknowledgment 120 is produced by a circuit in the near-end server 28). However, Albal fails to teach of the acknowledgment circuitry being adapted to transmit the acknowledgment to the transmitting location, wherein the last mentioned portion of the acknowledgment circuit is inactive until the funding means is confirmed. Maxwell discloses a system wherein a way location (netgram workstation 16) converts email messages sent from a first location into postal documents to be sent to a second location (see abstract). Further, Maxwell teaches of transmitting an acknowledgment (exception message or accept message) to the transmitting location, wherein the last mentioned portion of the acknowledgment circuit is inactive until the funding means is confirmed. (column 9, line 27 through column 10, lines 42).

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Maxwell's teachings in Albal, Kunigami, and Berkowitz's system, thereby including the acknowledgment circuitry being adapted to transmit the acknowledgment to the transmitting location, wherein the last mentioned portion of the acknowledgment circuit is inactive until the funding means is confirmed. Albal's system would become more user friendly with the addition of Maxwell's teachings, as the user of the transmitting station would be informed when the transmission process is complete.

Regarding *claim 68*, Albal, Kunigami, and Berkowitz disclose the system discussed above in claim 66, but fail to teach if the funding means includes at least a value data packet. Maxwell discloses a system wherein a way location (netgram workstation 16) converts email messages sent from a first location into postal documents to be sent to a second location (see abstract). Further, Maxwell teaches of a funding means which includes at least a value data packet (column 9, lines 19 through 47). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Maxwell's teachings in Albal, Kunigami, and Berkowitz's system. Albal's system would become more efficient with the addition of Maxwell's teachings, as value data would be transmitted to the funding means via a value packet, therein maintaining the transmission operation because the required postage is received.

Regarding *claim 69*, Albal, Kunigami, Berkowitz, and Maxwell disclose the system discussed above in claim 68, and Kunigami discloses a system wherein a value is deducted from a credit stored at the transmitting location (column 7, line 40 through column 8, line 11, and Fig. 11C, wherein Fig. 11C shows a generated report which is sent to the sender 1, showing that the

transmission fee is subtracted. Because the generated bill is issued to the sender, it would be obvious to a person of ordinary skill in the art that the value of the bill is deducted from a credit stored at the transmitting location, such as a checking account, credit card, credit register, postage meter, etc., all of which are well known in the art). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kunigami's further teachings in the combination system of Albal, Kunigami, Berkowitz, and Maxwell. Albal's system would become more efficient and more automated if modified to incorporate Kunigami's teachings, as the sender or receiver would be responsible for payment, wherein the intermediate station informs the receiver if the payment is performed by the sender.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-5406 for regular communications and (703) 306-5406 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrj
February 8, 2001


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